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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/693,382	10/23/2003	John K. Solheim	KMC-604	1641
7590 09/09/2005				
Darrell F. Marquette 2201 W. Desert Cove Phoenix, AZ 85029		EXAMINER HUNTER, ALVIN A		
		ART UNIT 3711 PAPER NUMBER		
DATE MAILED: 09/09/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/693,382

Applicant(s)

SOLHEIM ET AL.

Examiner

Alvin A. Hunter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,5-11,15 and 18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,5-11,15 and 18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC §102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 6-8, 10, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Cameron et al. (USPN 6231458).

Regarding claim 1, Cameron et al. discloses a club head body composed of a first material wherein the club head body having a rear surface, a heel end, a toe end, and a front face with a first cavity formed therein. The first cavity being defined by a bottom wall and a side wall wherein the club head body further comprises a plurality of apertures passing from the first cavity through the bottom wall thereof to the rear surface of the club head body wherein the apertures are devoid of threaded fasteners. The club head also comprises a face insert composed of a second material disposed within the first cavity and the face insert comprising a body with a front surface, a back surface and a lateral surface (See Figures 2, 13, and 15). Cameron et al. also discloses an adhesive layer disposed in the first cavity immediately adjacent the bottom wall of the cavity and the back surface of the face insert to adhere the face insert to the cavity wherein a portion of the adhesive layer extending into the aperture (See Figures 13 and

15, Column 3, lines 55 through 64, and Column 5, lines 11 through 13 and 21 through 30).

Regarding claim 6, Cameron et al. discloses a second cavity formed in the back surface of the face insert (See Figure 8).

Regarding claim 7, Cameron et al. discloses a cavity insert composed of a third material disposed in the second cavity (See Figure 8).

Regarding claim 8, Cameron et al. discloses the cavity insert composed of an elastomeric silicone compound.

Regarding claim 10, Cameron et al. disclose the face insert having a continuous lip extending outward laterally of the face insert sized and shaped to form a close tolerance fit with the side wall of the first cavity and adapted to center the insert into the cavity (See Figure 23).

Regarding claim 18, Cameron et al. discloses provide a club head body composed of first material, the club head body having a rear surface and a front face with a cavity formed therein, the cavity being defined by a bottom wall a side wall, the club head body further comprising a plurality of apertures passing from the cavity through the bottom wall thereof to the rear surface; providing a face insert composed of a second material, the face insert comprising a body having a front surface, a back surface and a lateral surface; pressing the face insert into the cavity; injecting an adhesive through one of the plurality of apertures until the adhesive flows out of at least one remaining of the plurality of apertures, and curing the adhesive, by atmospheric air, so that the face

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insert is attached to the club head body without the use of threaded fasteners (See Column 7, lines 46 through 50).

Claims 1 and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Boord (USPN 6729972).

Regarding claim 1, Boord discloses a club head body composed of a first material wherein the club head body having a rear surface, a heel end, a toe end, and a front face with a first cavity formed therein. The first cavity being defined by a bottom wall and a side wall wherein the club head body further comprises a plurality of apertures passing from the first cavity through the bottom wall thereof to the rear surface of the club head body wherein the first aperture is devoid of removable fasteners. The club head also comprises a face insert 29 composed of a second material disposed within the first cavity and the face insert comprising a body with a front surface, a back surface and a lateral surface (See Column 3, lines 37 through 64, and Figure 2). Cameron et al. also discloses an adhesive layer disposed in the first cavity immediately adjacent the bottom wall of the cavity and the back surface of the face insert to adhere the face insert to the cavity wherein a portion of the adhesive layer extending into the apertures (See Figure 13 and 15, Column 3, lines 55 through 64\*, and Column 5, lines 11 through 13 and 21 through 30).

Regarding claim 11, the method of assembly is implied as set forth above in claim 1 (Also See Column 7, lines 46 through 50).

Claim 11 is rejected under 35 U.S.C. 102(b) as being anticipated by Fisher (USPN 5921871).

Regarding claim 11, Fisher inherently discloses a method of manufacturing a golf club comprising providing a club head body composed of a first material, the club head body having a rear surface and a front face with a cavity formed therein, the cavity being defined by a bottom wall and a side wall, the club head body further comprising an aperture passing from the cavity through the bottom wall thereof to the rear surface; providing a face insert composed of a second material, the face insert comprising a body having a front surface, a back surface and a lateral surface: applying an adhesive layer between the bottom wall of the cavity and the back surface of the face insert; and pressing the face insert into the cavity so that any air trapped between the face insert and the bottom wall of the cavity escapes through the aperture. Fisher inherently discloses pressing the face insert farther into the cavity until the adhesive layer comes into contact with and bonds to the back surface of the face insert and the bottom wall of the cavity. This is because the front face has to be flush with the front surface of the club head body as show in Figure 15 (Alco See Column 7, lines 46 through 50).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cameron et al. (USPN 6231458).

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Regarding claim 5, in the alternative, patentability cannot be granted on aesthetics. Cameron et al. discloses the apertures providing the same utility as that of the applicant's', therefore, it is submitted that the shape of apertures are an obvious matter of design choice. Furthermore, Cameron et al. notes that the geometry of the apertures may be modified (See Column 6, lines 63 and 64). One having ordinary skill in the art would have found it obvious to have the apertures of any shape, including English letters, so long as the invention disclosed by Cameron et al. is attained.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fisher (USPN 5921871) in view of Grace et al. (USPN 5924939).

Regarding claim 15, Fisher does not disclose a cavity insert inserted into the face insert. Grace et al. discloses a golf club head having a face insert 7 wherein a cavity insert 6 is inserted into the face insert (See Figure 4 and Summary of the invention). One having ordinary skill in the art would have found it obvious to place a cavity insert within a face insert, as taught by Grace et al., in order to provide a soft feel to the golf club as well as aesthetics.

### ***Response to Arguments***

Applicant's arguments filed with respect to claims 1, 5-11, 15, and 18 have been fully considered but they are not persuasive.

Applicant argues that Fisher does not teach an adhesive layer between the front surface of the cavity in the club head body and the back surface of the face insert. The examiner disagrees. Applicant did not appreciate the cited prior art within the Final Rejection dated 5/18/2005, in which included literature showing that silicone is

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inherently an adhesive. Furthermore, Cameron et al. does not need threaded fasteners to attain the invention. This evident by the additional embodiments disclosed by Cameron et al. For these reasons, the above rejection has been furnished.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alvin A. Hunter whose telephone number is (571) 272-4411. The examiner can normally be reached on Monday through Friday from 7:30AM to 4:00PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich, can be reached on 571-272-4415. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*AHJ*

Alvin A. Hunter, Jr.

  
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